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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/697,005	10/25/2000	Albert Evaraerts	56117 USA 1A	4526
32692	7590	03/15/2004	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			FISCHER, JUSTIN R	
			ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 03/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/697,005

Applicant(s)

EVARAERTS ET AL.

Examiner

Justin R Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19-44 is/are pending in the application.
- 4a) Of the above claim(s) 19-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on February 18, 2004 has been entered.

#### ***Election/Restrictions***

2. This application contains claims directed to the following patentably distinct species of the claimed invention: a method of applying a pressure sensitive adhesive comprising a liquid plasticizing agent (Invention I) or a solid plasticizing agent (Invention II).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, there are no generic claims.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. Newly submitted claims 19-33 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 19-33 require the plasticizing agent to be in liquid form while claims 34-44 require the plasticizing agent to be in solid form. In particular, the previously presented claims (claim 4) were directed to a solid plasticizing agent.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 19-33 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

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***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 34, 35, and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following language appears in claim 35, lines 1 and 2 and in claim 40, lines 1 and 2: "the plasticizing agent is applied in selective regions to the latent, over tackified, adhesive on the substrate". However, claim 35 is dependent from claim 34 in which the adhesive and the plasticizing agent are simultaneously applied to the substrate. It appears that the current language of claim 35 is directed to the alternative embodiment of the claimed invention in which the plasticizing agent is applied to the adhesive subsequent to the application of the adhesive to the substrate (as compared to being simultaneously applied). As such, it is unclear how the limitations of claim 35 and 40 further define the embodiment in which the respective components are simultaneously applied.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 34-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Fukumoto (JP 62-263270). Fukumoto is directed to a method of applying a pressure

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sensitive adhesive to a substrate comprising the steps of providing a substrate (e.g. polyurethane), applying a mixture comprising a latent, over-tackified adhesive and a solid plasticizing agent to said substrate, and applying heat to melt said solid plasticizing agent and activate said adhesive (Derwent Abstract, JPO Abstract, and oral translation from USPTO translator). The adhesive (resin substance) of Fukumoto is seen to constitute a "latent, over-tackified adhesive" since the adhesive properties are not due to a relatively large amount of tackifier but rather acquire adhesivity upon activation by the heating and melting the plasticizing agent (this is the definition given in the original disclosure- Page 2, Line 33+). Furthermore, after applying heat and activating the adhesive, Fukumoto describes placing a second substrate, for example a plastic or metal sheet, over the activated adhesive (oral translation from USPTO translator).

Regarding claims 35 and 36, as noted in the 112, 2<sup>nd</sup> Paragraph rejections above, these limitations do not appear to further limit the embodiment in which the respective components are simultaneously added. Furthermore, the language "selective regions" does not exclude the placement of the plasticizing agent over the entire extent of the adhesive.

With respect to claims 37 and 41, the solid plasticizers of Fukumoto, for example dicyclohexyl phthalate, are seen to constitute non-reactive additives.

As to claims 38 and 42, Fukumoto suggests a pressure sensitive adhesive formed of styrene-butadiene rubber (falls under "synthetic rubber" category of the claimed invention).

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Regarding claims 43 and 44, the article of Fukumoto is seen to constitute an adhesive article in that it is formed in an analogous manner to the claimed invention (i.e. a base substrate is coated with a mixture of adhesive and plasticizing agent and subsequently heated to impart adhesivity). Also, the article at this point is seen to constitute a "tape" in that said mixture is coated onto a sheet, there being no specific structure or disclosure that defines a "tape" as being different or distinct from the article of Fukumoto.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ijichi (US 4,021,391) is directed to a method of applying a pressure sensitive to a base substrate comprising the steps of coating a substrate or support with a mixed composition (comprises adhesive, tackifier, and plasticizing agent) and subsequently applying heat to completely react said composition (forms adhesive). In this instance, Ijichi suggests that the plasticizing agent can be applied as a solid.

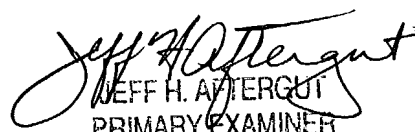
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Justin R Fischer** whose telephone number is **(571) 272-1215**. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Justin Fischer

March 1, 2004

  
JEFF H. AFTERGUT  
PRIMARY EXAMINER  
GROUP 1300